

REMARKS

Claims 1-7 are pending in the application.

The Office provisionally rejected claims 1-7 under 35 U.S.C. 101 for statutory type double patenting over claims 1-7 of co-pending U.S. Patent application Serial No. 10/065,604. A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent.

Applicants believe that pending claims 1-7 of the present invention, if allowed as written, could be literally infringed without infringement of presently pending claims 1-5 of co-pending U.S. Patent application Serial No. 10/065,604. This could be done by using the PCD element of claim 1 of the present invention in applications other than drill bits – for instance using it as a wire-drawing die.

Furthermore, Applicants believe that the presently pending claims 1-5 of co-pending U.S. Patent application Serial No. 10/065,604 could be literally infringed without infringement of claims 1-7, of the present invention - if allowed as written - by making a PCD element that does not have a substrate or has a substrate that is substantially affected by the treatment process.

Accordingly, Applicants respectfully request the office withdraw the provisional rejection of claims 1-7 under 35 U.S.C. 101 for statutory type double patenting.

The Office rejected claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over Newton, Jr. et al U.S. Patent 4,844,185 in view of Oles (6,344,149). Applicant has filed with this response a Declaration of Greg Petterson under 37 C.F.R. § 1.132. This declaration contains objective evidence of the non-obviousness of the invention; in particular, proof of its commercial success.

Consideration of objective evidence of non-obviousness, such as commercial success of the invention, is a necessary part of the obviousness determination. WMS Gaming Inc. v.

International Game Technology, 51 U.S.P.Q.2d 1385, 1400 (Fed. Cir. 1999); Tec Air, Inc. v. Denso Mfg. Michigan Inc., 52 U.S.P.Q.2d 1294, 1298-99 (Fed. Cir. 1999).

Mr. Petterson is the Marketing Manager for ReedHycalog U.K. Limited, the assignee of this patent application. As he explains in his declaration, ReedHycalog sells two types of drill bits: fixed cutter drill bits and rolling cutter drill bits. Some of the fixed cutter drill bits sold by ReedHycalog have "TReX" polycrystalline diamond cutters, and are made using the manufacturing method that is claimed in this patent application.

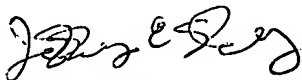
Mr. Petterson explains in his declaration that fixed cutter drill bits equipped with TReX cutters drill faster and last longer than fixed cutter drill bits that have conventional cutters, and as a result, they have received a very favorable reception from customers. From January to early June, 2003, sales of ReedHycalog fixed cutter drill bits with TReX cutters totaled approximately \$41,000,000, up from essentially zero sales only three years before. Sales of fixed cutter bits equipped with TReX cutters now make up about 67% of total fixed cutter bit sales at ReedHycalog, and if not for manufacturing capacity constraints, that figure would be almost 100%.

This commercial success demonstrates that the claimed invention is not obvious. If the invention were obvious, it would not have met with such rapid and dramatic acceptance in the marketplace. Therefore, applicant contends that the § 103(a) rejection should be withdrawn.

Applicants therefore believe that claims 1-7 are allowable, and respectfully request allowance of claims 1-7.

It is believed that there are no fees due at this time. However, the Commissioner is hereby authorized to charge any fees that may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account 180584. If there are any questions concerning the above, please contact the undersigned at 832-681-8623.

Respectfully submitted,



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